

REMARKS

Summary of the Office Action

In the Office Action, claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,004,142 to *Olesen*.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Olesen* in view of U.S. Patent No. 5,516,025 to *Eriksson*.

Summary of the Response to the Office Action

Applicant amends claim 1 to correct minor informalities and better clarify the invention. Claim 6 is added to provide an alternative scope of protection. Accordingly, claims 1-6 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-5 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant has amended independent claim 1 in order to expedite the prosecution of this case. Applicant respectfully submits that the amendments to claim 1 do not narrow the intended scope of the claim, and therefore, Applicant does not intend to relinquish any subject matter by these amendments. Applicant respectfully submits that claims 2-5 meet all the requirements of 35 U.S.C. § 112, as in amended claim 1. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,004,142 to *Olesen*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the Office Action has not established that *Olesen* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 1 recites, in part, "wherein upper surfaces of the clinchers are positioned lower than an upper surface of the clincher holder when the clincher actuating member is positioned in a top dead center position, so as to prevent the clincher from protruding beyond the clincher holder to the sheets of paper when the legs of the staple are bent along the reverse side of the sheets of paper." As such, *Olesen* fails to teach or suggest at least these features of claim 1.

The Office Action equates clinchers 15a and 15b of *Olesen* with the claimed present invention clinchers 23 and 24. *Olesen* discloses clinchers, 15a and 15b in Fig. 3, that extend beyond the clincher holder (not shown numerically) in *Olesen*. See Fig. 3 and col. 1, lines 59-62 of *Olesen*. The clincher holder is assumed to be the cross-hatched structure shown in Figs. 3 and 4 of *Olesen*. Thus, *Olesen* is the same configuration described in the present invention's background section, the same configuration that the present invention improves upon. Accordingly, *Olesen* fails to teach or suggest each and every feature of claim 1 because clinchers 15a and 15b extend beyond the cross-hatched clincher holder (not shown numerically) "when the legs of the staple are bent along the reverse side of the sheets of paper," as seen in Fig. 3 of

Olesen. Thus, the rejection of claim 1 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Olesen* does not teach or suggest each feature of newly amended independent claim 1.

Additionally, Applicant respectfully submits that dependent claims 2-5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Olesen* in view of U.S. Patent No. 5,516,025 to *Eriksson*. Applicant respectfully traverses the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Olesen* and *Eriksson*, whether alone or in combination, fail to teach or suggest all the recited features of newly amended independent claim 1. Claim 1 recites, in part, “wherein upper

surfaces of the clinchers are positioned lower than an upper surface of the clincher holder when the clincher actuating member is positioned in a top dead center position, so as to prevent the clincher from protruding beyond the clincher holder to the sheets of paper when the legs of the staple are bent along the reverse side of the sheets of paper.” *Olesen* or *Eriksson*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 1.

The Office Action equates “the clincher actuating member comprises a pair of cam members respectively provided for the pair of clinchers,” recited in claim 5 with the operating member 7’ of *Eriksson*. See Fig. 2 and col. 3, lines 34-40 of *Eriksson*. The Office Action does not identify where in *Eriksson* it is taught or suggested that the operating member 7’ is a cam. Thus, *Eriksson* does not teach or suggest “a pair of cam members,” as asserted in the Office Action. Further, *Eriksson* does not make-up for the deficiencies of *Olesen* above-demonstrated. Accordingly, *Eriksson* fails to teach or suggest each and every feature of claim 5. Thus, the rejection of claim 5 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Olesen* and *Eriksson*, whether taken alone or in combination, fails to teach or suggest each feature of independent claim 1, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claim 5 depends from independent claim 1. Accordingly, claim 5 is also allowable because of the additional features it recites and the reasons stated above.

New Claim

Applicant respectfully requests allowance of independent claim 6, which has features similar to that of claim 1 which have been demonstrated to be allowable. Accordingly, in view of the above, claim 6 is allowable and pending for further consideration.

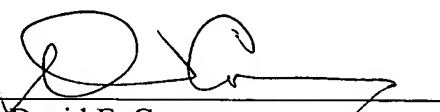
CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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